

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed October 27, 2006. Reconsideration and allowance of the application and pending claims are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 112, First Paragraph

Claims 1-8, 10-13, 15, 17, 18, 20, 22, 23, 25, 26, 28, 29, 31, 32, 35-38, 39, and 40 have been rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter that allegedly was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors had possession of the claimed invention at the time the application was filed.

The purpose of the written description requirement of 35 U.S.C. § 112, first paragraph, is to ensure that the inventor had *possession*, as of the filing date of application relied upon, of the specific subject matter later claimed by him. *Application of Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976); *Application of Edwards*, 568 F.2d 1349, 1351, 196 USPQ 465, 467 (CCPA 1978). This possession requirement ensures that the applicant actually invented the later claimed subject matter at the time the patent application was filed. As stated by the Court of appeals for the Federal Circuit (hereinafter "Federal Circuit"):

Satisfaction of the description requirement ensures that subject matter presented in the form of a claim subsequent to the filing date of the application was sufficiently disclosed at the time of filing so that a *prima facie* date of invention can fairly be held to be the filing date of the application.

Eiselstein v. Frank, 52 F.3d 1035, 1039, 34 USPQ 2d 1467, 1470 (Fed. Cir. 1995). With possession being the key to satisfying the written description requirements of 35 U.S.C. § 112, first paragraph, the test for establishing that adequate written description simply concerns showing evidence that such possession existed. As has been repeatedly stated by both the Court of Customs and Patent Appeals and the Federal Circuit:

[A]ll that is required is that it [the applicant] *reasonably conveyed* to persons skilled in the art that, as of the filing date thereof, the inventor had *possession* of the subject matter later claimed by him.

Eiselstein, 52 F.3d at 1039, 34 USPQ2d 1467, 1470 (emphasis added). *See also*, *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1158, 47 USPQ2d 1829, 1832 (Fed. Cir. 1998) ("To meet this requirement, the disclosure of the earlier application, the parent, must reasonably convey to one of skill in the art that the inventor possessed the later-claimed subject matter at the time the parent application was filed"); *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991) ("The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter."); *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (If adequate description support exists, the application relied upon "reasonably conveys to the artisan that the inventor had possession at the time of the later claimed subject matter."). This legal precedent makes it clear that it is well-established, indeed axiomatic, that, to comply with written

description requirement of 35 U.S.C. § 112, first paragraph, all that is required is that applicant "reasonably convey" to persons having ordinary skill in the art that, as of the filing date, the inventor possessed the subject matter at issue.

In the present case, Applicant clearly had possession of the claimed subject matter given that Applicant's specification "reasonably conveyed" that Applicant possessed that subject matter as of the time of filing. Applicant addresses the various claims in the following.

A. Claims 1, 9, and 34

Regarding claims 1, 9, and 34, the Examiner alleges that Applicant did not, at the time of filing, have possession of the limitation "such that the electrical device can display the particular graphic in a control panel display of the electrical device each time a given electrical device state is entered", which appears in claims 1 and 9, and "displaying the selected graphical data in the printer control panel display each time the electrical device enters the given state", which appears in claim 34. As an initial matter, Applicant notes that the above limitations were added to the claims to distinguish over the prior art that had previously been applied against Applicant's claims. In particular, the limitations were added to distinguish over the Parulski reference, which only teaches transmitting captured images from a camera to a printing device and presenting those images as *print previews* in a display of the printing device to facilitate selection and printing of the images. Therefore, unlike as in Applicant's invention, the images sent to the Parulski printer are not displayed in relation to particular printer states.

Applicant's specification describes the action of displaying certain graphics when particular device states are entered. For example, Applicant's specification states that:

. . . graphical data stored on the electrical device 102 can be used to present one or more graphics to the user depending upon the operational state of the device.

Applicant's specification, page 11, lines 5-7. As further described by Applicant:

. . . the user can specify whether the graphics are to be . . . displayed by the device for particular states of electrical device operation.

Applicant's specification, page 12, lines 11-15. Furthermore, Applicant disclosed that:

. . . the graphical data can be transmitted as a package to the electrical device. In this case, the command also identifies when the graphics are to be displayed. For example, where the data is to be displayed during device initialization (i.e., booting), the command identify the graphical data can comprise the variables "PJL INITGRAPICS". Similarly, where the data is to be displayed during a ready state, operating state, or power-save state, the commands can, for instance, comprise the variables 'PJL RDYGRAPHICS", "PJL OPGRAPHICS", and "PJL PWR SAVEGRAPHICS", respectively.

Applicant's specification, page 13, lines 14-21. Moreover, Applicant stated that:

. . . activation [of graphics display] occurs in response to a graphic display stimulus received by the display control module 218. . . the stimulus can comprise detection of a particular electrical device state where the display

control module 218 is configured to display particular graphics for particular device states (e.g., initiation, ready, operating, and power save states).

Applicant's specification, page 14, lines 15-22. Applicant further stated:

Where the stimulus is detection of a particular electrical device state in which a particular graphic is to be displayed, determination can comprise consulting an appropriate look-up table that identifies which graphic or graphics stored in the graphic store 220 is/are to be displayed for that state.

Applicant's specification, page 15, line 5-8. Further still, Applicant disclosed the following:

With reference to FIG. 6A, if the electrical device 102 is used by the Boein Company, a Boeing logo 600 can be displayed in the display 208 during booting of the device. With regard to FIG. 6B, if the electrical device is owned by Kinkos, Inc., a "Welcome to Kinkos" message 602 can be displayed to the user during the ready state of the electrical device 102. Turning to FIG. 6C, operation of the electrical device 102 can cause a train animation 604 to be displayed. . . . Finally, with regard to FIG. 6D, an Energy Star symbol can be shown during a power save state of the electrical device 102 to identify that the device is compliant with the Energy Star Program of the U.S. Environmental Protection Agency (EPA).

Applicant's specification, page 16, lines 11-21.

Applicant acknowledges that the phrase "each time a given electrical device state is entered" does not literally appear in the excerpts reproduced above. However, that a

particular graphic is displayed each time a given electrical device state is entered is clearly conveyed by those excerpts. For example, when Applicant states that a graphic is displayed "depending upon the operational state of the device" (page 11), it is clear that when the device is in a given state, a given graphic is displayed. Because the states identified by Applicant clearly are recurring states (e.g., "initiation, ready, operating, and power save states"; page 14), it logically follows that the graphic is displayed whenever the device is in that particular state, or stated otherwise, "each time" the device is in that state. Furthermore, when Applicant describes that the "stimulus" for displaying a particular graphic is "detection" of a given device state (page 14), it is clear that the associated graphic will be displayed each time that stimulus is detected. Moreover, when Applicant describes a "look-up table" that associates device states with graphics to be displayed, it is clear to readers having ordinary skill in the art that a given graphic will be displayed whenever its associated state identified in the look-up table is active.

In short, Applicant asserts that a person having ordinary skill in the art would readily appreciate from Applicant's disclosure that Applicant's graphics are displayed when certain recurring device states occur and, therefore, are displayed each time those states are entered. Such a person certainly would not interpret Applicant's disclosure as suggesting that a graphic is only displayed the first time a given state is entered, as the Examiner appears to be arguing. If that is the Examiner's argument Applicant notes that Applicant describes no process or mechanism for so limiting display of the graphics. Moreover, although it would be possible to terminate display of a graphic by, for instance, removing it from a look-up table used to determine what graphic to display, such an action would not change the fact that the graphic still would

have been presented each time its associated state occurred prior to its removal from the table.

In view of the above, Applicant asserts that Applicant has reasonably conveyed to persons skilled in the art that, as of the filing date, the inventor had possession of displaying a particular graphic "each time a given electrical device state is entered". If the Examiner disagrees, Applicant requests the Examiner to identify with specificity what portions of Applicant's disclosure would suggest to a person having ordinary skill in the art that Applicant's graphics were *not* intended to be displayed each time a given device state occurred.

B. Claims 14 and 19

Regarding claims 14 and 19, the Examiner alleges that Applicant did not, at the time of filing, have possession of the limitation "graphical data . . . having been selected by a user . . . only for the purpose of repeated display during a given state of the electrical device", which appears in claim 14, or "receiving graphical data . . . whose purpose is for repeated display during a given state of the electrical device", which appears in claim 19. Given that the Examiner does not specifically identify which portions of those phrases he believes are not supported by Applicant's specification, Applicant will assume that the Examiner takes issue with the concept of "repeated display during a given state of the electrical device", which appears in both claims 14 and 19.

On the issue of repeated display depending upon the device state, Applicant refers to the discussion of the limitations of claims 1, 9, and 34 presented above. Again, it is clear from Applicant's specification that the graphics are associated with recurring device

states and therefore will be displayed each time one of those device states occurs. Because the device states are recurring states, as would be readily appreciated by a person having ordinary skill in the art, it logically follows that "repeated" display of the graphics would occur. For instance, if a graphic is to be displayed in association with device operation (e.g., printing), it follows that the graphic will be displayed each time the device operates (e.g., prints) and, hence, will be repeatedly displayed.

In addition to the "repeated" limitation, the Examiner further takes issue with the limitation "each time the electrical device state occurs", which appears in both claims 14 and 19. Applicant again refers to the discussion of the limitations of claims 1, 9, and 34 presented above, which clearly establishes that Applicant's specification reasonably conveys display of a graphic each time a device state occurs.

C. Conclusion

In summary, Applicant asserts that the written description requirement of 35 U.S.C. § 112, first paragraph is satisfied by Applicant's originally-filed specification. Accordingly, Applicant requests that the rejections under 35 U.S.C. § 112, first paragraph, be withdrawn.

II. Claim Rejections - 35 U.S.C. § 112, Second Paragraph

Claims 1-8, 10-13, 22, 23, 25, 26, 35-38, and 40 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

Specifically, the Examiner rejects claims 1, 9, and 34 for containing the same limitations that the Examiner objected to under 35 U.S.C. § 112, first paragraph.

In response, Applicant asserts that meaning of the limitation "each time a given electrical device state is entered" is clear. Specifically, the limitation means that something happens (display of a graphic in this case) each time a given state of the device is entered. Therefore, if the device receives a print job and begins the print process, the device has entered an operating state and an associated graphic will be displayed. Applicant further notes that the specification provides clear support for the above limitation at issue. For instance, multiple examples of graphics display are described in relation to the device entering a variety of states on page 16.

In view of the above, it is respectfully asserted that the claims define the invention in the manner required by 35 U.S.C. § 112, second paragraph. Accordingly, Applicant respectfully requests that the rejections under 35 U.S.C. § 112, second paragraph be withdrawn.

III. Allowable Subject Matter

Applicant notes that the Examiner has not rejected any of the claims on prior art grounds. Applicant further notes that the Examiner is not excused from presenting any prior art rejections just because he has rejected each of the claims under 35 U.S.C. § 112. For example MPEP 2163, part III provides (emphasis added):

Regardless of the outcome of the [35 U.S.C. § 112] determination, Office personnel must complete the patentability determination under all the relevant statutory provisions of title 35 of the U.S. Code.

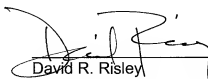
Once Office personnel have concluded analysis of the claimed invention under all the statutory provisions, including 35 U.S.C. 101, 112, 102, and 103, they should review all the proposed rejections and their bases to confirm their correctness.

Given that no 102 or 103 rejections have been issued, Applicant presumes that each of Applicant's claims contains allowable subject matter and requests that the Examiner explicitly state so in his next paper. If by chance the Examiner failed to present a prior art rejection in error and wishes to do so in a further Office Action, that further Action *must* be non-final.

CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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